	Application No.	Applicant(s)
Notice of Allowability	09/726,277	HAGELIN, THEODORE
	Examiner	Art Unit	
	Freda A. Nelson	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *Amendment filed September 19, 2006*.

2. ☒ The allowed claim(s) is/are *4, 6-8, 13-14, 18-21 and 25-27*.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some*   c) ☐ None   of the:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

     * Certified copies not received: _____ .

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

     (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

         1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____ .

     (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____ .

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)

2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)

3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____

4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

5. ☐ Notice of Informal Patent Application

6. ☒ Interview Summary (PTO-413), Paper No./Mail Date *11/21/06* .

7. ☒ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other _____ .

Response to Amendment

The amendment received on September 19, 2006 is acknowledged and entered.

Claims 4, 13, 18-21, and 25-27 have been amended. Claims 1-3, 5, 9-11, 15-17, and

22-24 have been canceled. No claims have been added. Claims 4, 6-8, 13-14, 18-21,

and 25-27 are currently pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

September 19, 2006 has been entered.

The rejection under 35 USC 101 has been withdrawn due to applicant's

amendment.

The drawing(s) filed on November 30, 2000 are accepted by the Examiner.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes

and/or additions be unacceptable to applicant, an amendment may be filed as provided

by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be

submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview

with George R. McGuire (Reg No. 36,603) on November 21, 2006

The application has been amended as follows:

IN THE CLAIMS:

Claim 12. (Cancelled)

Claim 7. (Currently Amended) A method of valuing a pre-market product using a

data processing system, comprising the steps of:

using said data processing system to determine the present monetary value of

an intended market for said pre-market product;

inputting into said data processing system a plurality of parameters of said pre-

market product and a plurality of corresponding parameters of competing products in

said intended market;

using said data processing system to compare said plurality of parameters of

said pre-market product to said plurality of corresponding parameters of competing

products in said intended market and determine a competitive advantage for each said

parameter of said pre-market product as a percent variation;

inputting weights for each said competitive advantage of each said parameters

into said data processing system and averaging said competitive advantages of the

parameters in said data processing system to determine said competitive advantage of

said pre-market product in said market;

predicting a market share of said pre-market product based on said competitive

advantage calculated by said data processing system; and

using said data processing system to calculate a monetary value for said pre-

market product by multiplying said predicted market share and said present monetary

value of said intended market; and

displaying said monetary value using said data processing system.

20.   (currently amended) A method of determining the monetary value of an

intangible property license between a licensor and a licensee using a data processing

system, comprising the steps of:

using said data processing system to calculate [[a]] an increase in a competitive

advantage of said tangible asset as a percent variation due to said intangible asset

subject to said license for said licensee;

using said data processing system to calculate a decrease in a competitive

advantage of said tangible asset as a percent variation due to said intangible asset

subject to said license for said licensor;

using said data processing system to determine a monetary value of said

tangible asset by multiplying a monetary value for a market for said tangible asset and

an average percent market share in said market;

using said data processing system to determine a minimum monetary value to said licensor by multiplying said percent decrease by said monetary value of said tangible asset;

using said data processing system to determine a maximum monetary value to said licensee by multiplying said percent increase by said monetary value of said tangible asset;

using said data processing system to calculate a net monetary value by subtracting a minimum monetary value to said licensor from a maximum monetary value to said licensee;

using said data processing system to determine an equal return payment that provides an equal return on investment to the licensor and licensee; calculating said monetary value to the licensor as equal to said equal return payment; and

using said data processing system to calculate said monetary value to the licensee by subtracting said equal return payment from said net value.

Allowable Subject Matter

Claims 4, 6-8, 13-14, 18-21, and 25-27 are allowed.

The following is an examiner's statement of reasons for allowance:

1.   As per independent claim 4, specifically, Elliott (US 2003/0061064), while

disclosing a method for obtaining and allocating investment income based on the

capitalization of intellectual property does not disclose or fairly teach:

        identifying a parameter dependent on said intangible asset and associated with

said tangible asset that is relevant to commercial success in a marketplace;

        calculating said relative contribution of said intangible asset to said competitive

advantage of said tangible asset based on a contribution of said parameter to said

competitive advantage of said tangible asset as compared to related intangible assets;

and

        multiplying said relative contribution of said intangible asset with said value of

said tangible asset.

2.   As per independent claims 7, 19, and 26, specifically, Elliott (US 2003/0061064),

while disclosing a method for obtaining and allocating investment income based on the

capitalization of intellectual property does not disclose or fairly teach:

        inputting into said data processing system a plurality of parameters of said pre-

market product and a plurality of corresponding parameters of competing products in

said intended market;

        using said data processing system to compare said plurality of parameters of

said pre-market product to said plurality of corresponding parameters of competing

products in said intended market and determine a competitive advantage for each said

parameter of said pre-market product as a percent variation; and

inputting weights for each said competitive advantage of each said parameters

into said data processing system and averaging said competitive advantages of the

parameters in said data processing system to determine said competitive advantage of

said pre-market product in said market;

predicting a market share of said pre-market product based on said competitive

advantage calculated by said data processing system; and

using said data processing system to calculate a monetary value for said pre-

market product by multiplying said predicted market share and said present monetary

value of said intended market

3.   As per independent claims 13, 21, and 27, specifically, Elliott (US

2003/0061064), while disclosing a method for obtaining and allocating investment

income based on the capitalization of intellectual property does not disclose or fairly

teach:

identifying at least one parameter associated with said tangible asset relevant to

commercial success in the marketplace;

using said data processing system to compare said parameter with at least one

parameter of at least one competing tangible asset to determine said competitive

advantage said tangible asset as a percent variation;

using said data processing system to calculate a competitive advantage for said

tangible asset without said new intangible asset as a percent variation;

using said data processing system to calculate a competitive advantage for said

tangible asset with said new intangible asset as a percent variation; and

using said data processing system to subtract said competitive advantage for

said tangible asset without said new intangible asset from said competitive advantage

for said tangible asset with said new intangible asset

4.   As per independent claim 14, specifically, Elliott (US 2003/0061064), while

disclosing a method for obtaining and allocating investment income based on the

capitalization of intellectual property does not disclose or fairly teach:

using said data processing system to calculate said average market share in said

intended market as a percent;

using said data processing system to determine an average product present

monetary value by multiplying said present monetary value of said intended market by

said average market share;

using said data processing system to multiply said average product present

monetary value and said change in said competitive advantage

5.   As per independent claims 18 and 25, specifically, Elliott (US 2003/0061064), while disclosing a method for obtaining and allocating investment income based on the capitalization of intellectual property does not disclose or fairly teach:

inputting into said data processing system a life cycle in years of said tangible

inputting into said data processing system a profit margin of said tangible asset as a percent of gross sales;

inputting into said data processing system a present value discount factor;

using said data processing system to sum a multiple of said total annual gross sales, said annual percent growth, said profit margin, and said present value discount factor over each year of said life cycle of said tangible asset;

identifying at least one parameter associated with said tangible asset relevant to commercial success in the market;

using said data processing system to compare said parameter with at least one parameter of at least one competing tangible asset to determine a competitive advantage of said tangible asset as a percent variation;

identifying a parameter dependent on said intangible asset and associated with said tangible asset that is relevant to commercial success in the market;

using said data processing system to calculate said relative contribution of said intangible asset to said competitive advantage of said tangible asset based on a contribution of said parameter to said competitive advantage of said tangible asset; and

using said data processing system to multiply said relative contribution of said intangible asset with said value of said tangible asset

6.   As per independent claim 20, specifically, Elliott (US 2003/0061064), while

disclosing a method for obtaining and allocating investment income based on the

capitalization of intellectual property does not disclose or fairly teach:

using said data processing system to calculate an increase in a competitive

advantage of said tangible asset as a percent variation due to said intangible asset

subject to said license for said licensee;

using said data processing system to calculate a decrease in a competitive

advantage of said tangible asset as a percent variation due to said intangible asset

subject to said license for said licensor;

using said data processing system to determine a monetary value of said

tangible asset by multiplying a monetary value for a market for said tangible asset and

an average percent market share in said market;

using said data processing system to determine a minimum monetary value

to said licensor by multiplying said percent decrease by said monetary value of said

tangible asset;

using said data processing system to determine a maximum monetary value to

said licensee by multiplying said percent increase by said monetary value of said

tangible asset;

using said data processing system to calculate a net monetary value by subtracting a minimum monetary value to said licensor from a maximum monetary value to said licensee;

using said data processing system to determine an equal return payment that provides an equal return on investment to the licensor and licensee; calculating said monetary value to the licensor as equal to said equal return payment; and

using said data processing system to calculate said monetary value to the licensee by subtracting said equal return payment from said net value.

7.   The NPL prior art of record, specifically, "Identifying, protecting and valuing intellectual property" and "Intellectual property valuation aids in high tech investments", fails to disclose or fairly teach:.

identifying a parameter dependent on said intangible asset and associated with said tangible asset that is relevant to commercial success in a marketplace;

calculating said relative contribution of said intangible asset to said competitive advantage of said tangible asset based on a contribution of said parameter to said competitive advantage of said tangible asset as compared to related intangible assets; and multiplying said relative contribution of said intangible asset with said value of said tangible asset.

8.   The foreign prior art of record, specifically, Eicher (CA 2,201,429) , while

disclosing valuing intellectual assets for creating an artificial intelligence system, fails to

disclose or fairly teach:

         identifying a parameter dependent on said intangible asset and associated with

said tangible asset that is relevant to commercial success in a marketplace;

         calculating said relative contribution of said intangible asset to said competitive

advantage of said tangible asset based on a contribution of said parameter to said

competitive advantage of said tangible asset as compared to related intangible assets;

and multiplying said relative contribution of said intangible asset with said value of said

tangible asset.

9.   The remaining dependent claims are considered allowable, as they are

dependent and based off of an allowable independent claim.

         Any comments considered necessary by applicant must be submitted no later

than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on
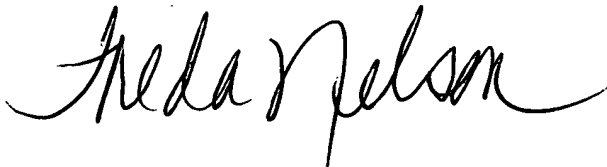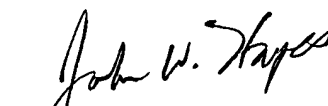
Statement of Reasons for Allowance."

         Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-

7076. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 11/24/2006

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER